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09/938,159	08/23/2001	Paul Clinton Coffin	10012828-1	1251

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

TRAN, HANH VAN

ART UNIT	PAPER NUMBER
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3637

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08/09/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/938,159

Applicant(s)

COFFIN ET AL.

Examiner

Hanh V. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21,22,24-29,35 and 37-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 60-62 is/are allowed.
- 6) ☒ Claim(s) 21,22,24-29,35 and 37-59, 63-67 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. In view of the arguments presented in the Appeal Brief filed on 3/23/2007 regarding claims 43 and 60, the following is a Non-Final Office action. Any inconvenience is regretted.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 43-46, 52 and 66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 43, line 17, "the reference rails" lacks antecedent basis, thus indefinite.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 50-51, and 67 are rejected under 35 U.S.C. 102(e) as being anticipated by USP 6,648,428 to Chaloner et al.

The applied reference has a common assignee with the instant application.

Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art

under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Chaloner et al discloses a data storage system comprising all the elements recited in the above listed claims including, such as shown in Figs 1-2, a data storage system housing 70 having an opening, first and second elongate reference rails 272,274, Fig 7, located adjacent the opening, a plurality of media storage devices 30,32 each having a housing movable between a storage position within the data storage system and an extended position, the housing having a top, a bottom and opposing ends, first and second elongate alignment grooves 276,278 adapted to slidably engage with the first and second elongate reference rails 272,274, Fig 21, of the data storage system housing, a locking plate attached to the housing and configured to engage a locking mechanism located in the opening in the data storage system, a handle operationally attached to the housing, a side portion of the housing having a plurality of slots configured to receive the data media, a plurality of dividers positioned in spaced-apart relation within the housing, supplemental slots (defined as the spaced between plate 124 and the front 62) separate from the media storage device, means for applying a force, guide rails 36, Figs 7-8, to enable movement of the drawer between the retracted and extended positions, wherein the media storage device may be inserted into and removed from the data storage system housing by slidably engaging the elongate reference rails and the elongate alignment grooves and guiding the media

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storage device through the opening of the data storage system housing along a longitudinal axis of the media storage device housing, the opposing ends of the media storage device housing being located along the longitudinal axis, the data media being inserted into and removed from the media storage device housing along an axis transverse to the longitudinal axis. Further, it is well known that a data storage system would include a data exchange device for reading data from the data media, and a media handling system for transferring data media from the media storage device to the data exchange device.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 21-22, 24-29, 35, 37-42, 47-49, and 55-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 6,116,063 to Foslien in view of USP 6,042,205 to Coffin et al and USP 5,537,371 to Niederlein et al.

Foslien discloses a data storage system 10 comprising all the elements recited in the above listed claims including, such as shown in Figs 1-3, a system housing 30

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having an opening, a media storage device 54 having opposite sides located between the top and bottom and extending parallel to the longitudinal axis, at least one of the opposing sides being configured to receive the data media and a plurality of slots 56,58 defined by a plurality of dividers positioned in space-apart relation within the media storage device housing (such as shown in Fig 2), a data exchange device (not shown), a media handling system (not shown), a locking plate, a handle 142 configured to enable an operator to apply a force, a plurality of movable drawers 54, guide rails (not numbered, such as shown in Fig 2) positioned at the bottom of the drawer to enable movement of the drawer between the retracted and extended positions, supplemental slots separate from the media storage device (defined as the space between the media storage device and the front/locking plate of the drawer), wherein the media storage devices stacked in a vertical stack arrangement,...

The differences being that Foslien does not clearly disclose the system housing having first and second elongate reference rails located adjacent the opening, the media storage device having first and second elongate alignment grooves each is adapted to slidably engage with a respective one of the first and second elongate reference structures, a spring mechanism comprising a first end and a second end, the first end being operationally attached to the top of the media storage device housing, a finger attached to the second end of the spring mechanism, wherein the spring mechanism comprises a metallic strip, and the spring mechanism and the finger are configured to engage and secure the data media in respective slots, an automated drive system adapted to, in response to user input, move the drawer between a retracted

position and an extended position, the drive system including a motor, and a drive gear driven by the motor, and the supplemental slots are defined by one or more slot dividers.

Coffin '205 teaches the idea of providing a media storage device housing with a spring mechanism comprising a first end and a second end, the first end being operationally attached to the top of the media storage device housing, a finger attached to the second end of the spring mechanism, wherein the spring mechanism comprises a metallic strip, and the spring mechanism and the finger are configured to engage the data media for the purpose securing the data media within the media storage device housing. While Niederlein teaches that it is well known in the art to provide the system housing with first and second elongate reference rails located adjacent the opening, the media storage device with first and second elongate alignment grooves each is adapted to slidably engage with a respective one of the first and second elongate reference structures for the purpose of facilitated moving the drawer between the retracted and extended positions. Therefore, it would have been obvious to modify the structure of Foslien by providing a spring mechanism comprising a first end and a second end, the first end being operationally attached to the top of the media storage device housing, a finger attached to the second end of the spring mechanism, wherein the spring mechanism comprises a metallic strip, and the spring mechanism and the finger are configured to engage the data media for the purpose securing the data media within the media storage device housing, as taught by Coffin et al, and providing the system housing having first and second elongate reference rails located adjacent the opening,

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the media storage device having first and second elongate alignment grooves each is adapted to slidably engage with a respective one of the first and second elongate reference structures for the purpose of facilitated moving the drawer between the retracted and extended positions, as taught by Niederlein, since the references teach alternate conventional media storage device, used for the same intended purpose, thereby providing structure as claimed. In regard to the limitation in claim 47 of an automated drive system adapted to, in response to user input, move the drawer between a retracted position and an extended position, the drive system including a motor, and a drive gear driven by the motor, it is well known in the art to provide a storage system with an automated drive system in order to facilitate opening and closing of the drawer, thus it would have been obvious to modify the structure of Foslien by providing the data storage system with an automated drive system adapted to, in response to user input, move the drawer between a retracted position and an extended position, the drive system including a motor, and a drive gear driven by the motor in order to facilitate opening and closing of the drawer (see also USP 6,065,819 to Holmes et al for the teaching of providing a storage system with an automated drive system in order to facilitate opening and closing of the drawer.) In regard to the supplemental slots are defined by one or more slot dividers, it is well known in the art to provide the interior of a drawer with one or more slot dividers in order to provide an organized drawer.

Response to Arguments

9. Applicant's arguments, see pages 8-12, filed 3/23/2007, with respect to claims 43 and 60 have been fully considered and are persuasive. The rejection of claims 43 and 60 has been withdrawn.

10. Applicant's arguments filed 3/23/2007 with respect to claims 21, 22, 24-29, 35, 37-42, 47-51, 53-59, 63-65 and 67 have been fully considered but they are not persuasive. In response to applicant's arguments that a *prima facie* case of obviousness has not been established with respect to each of the independent claims 21, 40, 47, 50, 53, and 54 and its dependent claims for at least the reason that no motivation or suggestion existed to combine the references each of, the examiner takes the position that the art rejection in paragraph #8 clearly set forth the motivation to combine the references "for the purpose securing the data media within the media storage device housing" and "for the purpose of facilitated moving the drawer between the retracted and extended positions".

11. In response to applicant's argument on page 14 regarding claim 47 that the examiner fails to cite any actual evidence that provides any teaching or suggestion of an automated drive system to move the drawer between a retracted position and an extended position, please see USP 6,065,819 to Holmes for the teaching of providing a storage system with an automated drive system in order to facilitate opening and closing of the drawer.

12. In response to applicant's argument on pages 15 and 16 regarding the supplemental slots, the examiner takes the position that the claimed language fails to

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provide adequate structural limitations in order to distinguish from the prior art of record, and figure 7 of Chaloner clearly shows plate 124 having a plurality of vertically extending ribs defining the supplemental slots.

Allowable Subject Matter

13. Claims 44-46, 52 and 66 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

14. Claim 43 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

15. Claims 60-62 are allowed.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hanh V. Tran whose telephone number is (571) 272-6868. The examiner can normally be reached on Monday-Thursday, and alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on (571) 272-6867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



HVT

August 06, 2007

Hanh V. Tran

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